

REMARKS

By this amendment, claims 1 and 3-13 are pending, in which claim 3 is canceled without prejudice or disclaimer, and claims 7-13 are newly presented. No new matter is introduced.

The Office Action mailed May 5, 2005 rejected claims 1-6 under 35 U.S.C. § 103(a) as obvious based on *Webber* (GB 2244907) in view of *Suzuki et al.* (JP 2001-157601) and *Suginaka* (US 5,063,692). Additionally, claim 3 was rejected as indefinite under 35 U.S.C. § 112, second paragraph.

Regarding the indefiniteness rejection, Applicants have canceled claim 3, thereby rendering the rejection moot.

With respect to the obviousness rejection over the combination of *Webber*, *Suzuki et al.*, and *Suginaka*, Applicants respectfully traverse such rejection as the combination fails to disclose all the features of the claimed invention.

Independent claim 1 recites “a second insole having an **inverted T-shaped projection part** comprising a **vertical projection part** projecting a little and **extending between the first and second toes** and a **lateral projection part extending under bases of the first and second toes.**”

The Office Action (on page 2, item 3) correctly acknowledges that *Webber* fails to disclose “a first insole (insole with partition wall) and a second insole (insole with T-shaped projection).” Consequently, the Examiner relies on *Suzuki et al.* for a supposed teaching of a “a first insole (insole) for a baby comprising a partition wall (18) as claimed” and *Suginaka* for a supposed teaching of a “second insole (insole pad) having an inverted T-shaped projection (15) as claimed.” However, the Examiner’s characterization of *Suginaka*’s triangular pyramidal shape extrusion as the T-shaped projection part of the claimed second insole is improper.

Suginaka discloses an insole with a triangular pyramidal shaped extrusion located to correspond to the concavity of a foot between the first and second toes (col. 4, lines 45-60). The extrusion 15 is only intended to prevent slippage (col. 2, line 63). *Suginaka* further describes (col. 3: lines 64-66) that the concavity between the first and second toes is placed on the extrusion 15. However, there is no disclosure of “**a vertical projection part projecting a little and extending between the first and second toes,**” as positively recited in independent claim 1.

To better appreciate this important distinction, the purpose of this vertical projection part, according to one embodiment, is fully explained in the Specification. For example, the Specification discloses that “[s]ince the baby pinches the projection by the first and second toes, the existence of the projection promotes the formation of the arch of the foot of the baby” (page 7, lines 5-7).

Even assuming the three references were properly combined based on some teaching or suggestion in the references, and assuming the modifications proposed in the Office Action were justified by additional teachings or suggestions found in the references, even the combination does not render the claimed invention obvious. Specifically, none the references taken alone, or in combination, teaches or suggests “**a vertical projection part projecting a little and extending between the first and second toes.**” Therefore, Applicants submits that the limitations of independent claim 1 are not satisfied.

Furthermore, Applicants respectfully note that *Suginaka* teaches away the claimed invention, in that *Suginaka* describes that “the extrusion 15 for preventing slippage is formed to have a **low** generally triangular pyramidal shape **so that it is fit to the concavity** between the first and the second toes of the foot.” Therefore, *Suginaka* cannot contemplate that the extrusion extend between first and second toes, in the manner claimed, but in fact teaches away such feature as that would result in an extrusion that cannot fit in the concavity. A prior art reference

must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Therefore, Applicants respectfully submit that the Office Action has presented no substantial evidence showing a teaching or motivation to combine the prior art references.

Accordingly, Applicants respectfully request that the obviousness rejection be withdrawn, and urge the indication that claim 1 is allowable. Because claims 2 and 4-6 depend from independent claim 1, they are also in condition for allowance for at least the reasons for the allowability of claim 1.

Turning to the newly presented claims, claim 7-9 depend from independent claim 1, and thus should be allowable. New independent claim 10 is directed to an insole set for assisting with arch development and recites “a first insole having a partition wall rising between a first and second toes of a foot, wherein the partition wall has a soft outer material for contacting the toes and an upper end that is thickened; and **a second insole having a projection part comprising a vertical projection part extending between the first and second toes to permit pinching of the vertical projection part by the first and second toes**, the projection part further comprising a lateral projection part extending under the first and second toes.” New independent claim 12 is drawn to a method of assembling an insole set and recites “determining a stage of arch development of a foot; and selecting an insole from an insole set based on the determination, wherein the insole set comprises, a first insole having a partition wall rising between a first and second toes of the foot, the partition wall having a soft outer material for contacting the toes and an upper end that is thickened, and **a second insole having a projection part comprising a vertical projection part extending between the first and second toes to permit pinching of the vertical projection part by the first and second toes**, the projection part further comprising

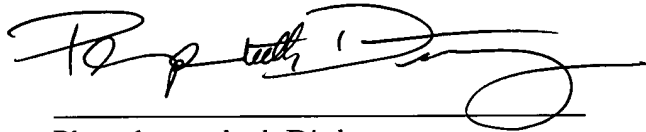
a lateral projection part extending under the first and second toes.” The art of record is devoid of these features; hence, new independent claims 10 and 12, as well as claims 11 and 13 depending correspondingly therefrom, should be indicated as allowable.

Therefore, the present application, as amended, overcomes the rejection of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8508 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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Date



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